

33-38 have been added. Support for these new claims can be found in the specification, for example, at pages 4, 6-7, and 12. No new matter has been added.

II. Summary of Interview

The undersigned wishes to thank the Examiner for the courtesies extended during the interview on December 20, 1999. The undersigned discussed the differences between applicants' invention and Faust et al. In particular, applicants' representative explained that Faust et al. teaches crushing the foam layer by mechanical embossing to a thickness that is less than the original unfoamed thickness of that layer. This crushing is required to make the foam layer transparent. Moreover, the mechanical embossing in Faust et al results in an embossment depth that is deeper than any chemical embossment. In contrast, at least a portion of the chemical embossment in the claimed invention is deeper than any mechanical embossment.

The Examiner acknowledged during the interview that the relative depths of chemical embossment versus mechanical embossment would appear to distinguish over Faust et al.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 9-10 and 21-32 under 35 U.S.C. § 103(a) as being unpatentable over Faust et al. The Examiner contends, inter alia, that Faust et al. discloses the basic claimed invention, including providing a surface covering including a backing layer, a foamable layer located atop the backing layer and a design layer located atop the foamable layer and having a design, wherein a portion of the

design includes a pattern with at least one retarder or inhibitor composition. The Examiner contends that Faust et al. discloses providing a wear layer on top of the design layer and curing the wear layer, thereby expanding the foamable layer to form a foam layer, and mechanically embossing and setting a surface texture on the wear layer.

Without admitting or denying the accuracy of all of the Examiner's contentions and arguments, Applicants respectfully traverse the Examiner's rejection as it applies to claims 23-26 and new claims 33-38 .

Applicants' claimed invention is directed to a method of making a surface covering with an embossed design using a combination of chemical and mechanical embossing. More particularly, the claimed invention relates to a multiple layer surface covering having a first layer and a second layer that is above the first layer. At least a portion of the first layer is chemically embossed and at least a portion of the second layer is mechanically embossed. A chemically embossed portion of the first layer has a depth that is greater than any embossed portion of the second layer.

The claimed invention is neither taught nor suggested by Faust et al. The invention described in Faust et al. relates to a mechanical embossing technique used to create a unique appearance on sheet-type covering materials such as vinyl flooring, and resulted from efforts by Faust et al. to develop alternatives to known chemical and mechanical embossing techniques which, at that time, were prone to problems. (Col. 1, lines 28-48.)

More specifically, the invention disclosed in Faust et al. relates to a process for making a decorative sheet covering material having a substrate, a pigmented layer, and a foamed plastic layer having selectively crushed, transparent portions through which the pigmented layer is visible. (Id., lines 57-61.) The selectively crushed layer preferably has printing thereon with a conventional wear layer over the printing. (Id., lines 61-64.)

Chemical embossing appears to be suggested by Faust et al. as one technique that may be combined with the mechanical embossing to obtain the unique appearance of the products of the Faust et al. invention. (Col. 4, lines 35-42.) However, the principal embossing technique disclosed in Faust et al. is mechanical embossing of the foamed layer.

The portion of the foam layer that is selectively, mechanically embossed is completely or substantially crushed to become transparent and allow the underlying pigmented coating or printing to show through. (Col. 3, lines 18-21.) Faust et al. teaches that the thickness of the crushed foamed layer is preferably between "about 50 and about 90 percent of the original thickness of the foamed plastic layer before foaming thereof [and] . . . the foamed portions of the layer are preferably between about 2 and about 4 times the original unfoamed thickness thereof." (Col. 5, lines 44-48.) (Emphasis added.)

As a consequence of the above processing described by Faust et al., the resulting product would have mechanically embossed portions that are deeper than any chemical embossed portions suggested by Faust et al.

The mere suggestion in Faust et al. that chemical embossing could be combined with the mechanical embossing disclosed therein in no way teaches or suggests making a surface covering having multiple layers and an embossed design, wherein a chemically embossed portion of a first layer has a depth greater than any mechanically embossed portion of a second layer. In fact, it is a teaching away. This is particularly true because Faust et al. teaches that the mechanical embossing step crushes the foam layer to 50-90% of its original thickness before foaming. Thus, the depth of any chemical embossing suggested by Faust et al. can not be greater than the depth of any mechanical embossing.

To establish a *prima facie* case of obviousness, the Examiner has the burden of showing that, among other things, there would be some motivation or suggestion to modify the reference teachings. Moreover, the Federal Circuit has said where a proposal to modify the art destroys the intended function of the art, the requisite motivation to make the modification does not exist. In re Fritch, 972 F.2d 1260, 1265-66 (Fed. Cir. 1992).

Modifying Faust et al. so that any suggested chemical embossing that is performed has a greater depth than any mechanical embossing would destroy the intended function of Faust et al., i.e., to create transparent portions by mechanically

crushing the foam to 50-90% of the thickness of the unfoamed layer. In other words, modifying Faust et al. along the lines suggested above would mean less crushing by mechanical embossing with a corresponding reduction in transparency. The net result would be a less desirable product. Faust et al. can not be misconstrued in this fashion. In sum, Faust et al. does not render the claimed invention *prima facie* obvious.

IV. Conclusion

The pending claims are in condition for allowance. An early and favorable action is respectfully requested.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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